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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,657

05/17/2006

Olivier Casula

434299-694

9371

46188

7590

01/21/2010

Nixon Peabody LLP  
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EXAMINER

BOR, HELENE CATHERINE

ART UNIT

PAPER NUMBER

3768

MAIL DATE

DELIVERY MODE

01/21/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,657	<b>Applicant(s)</b> CASULA ET AL.	
	<b>Examiner</b> HELENE BOR	<b>Art Unit</b> 3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/21/2009 has been entered.

### ***35 U.S.C. 112, 2nd Paragraph***

2. The rejection of Claims 1-14 under 35 U.S.C. 112, 2nd paragraph is hereby maintained.

### ***Claim Rejections - 35 USC § 102***

3. The rejection of Claims 1-6 & 12-14 under 35 U.S.C. 102(b) as being anticipated by Bolomey et al. (US Patent No. 6,424,597) is hereby maintained.

### ***Claim Rejections - 35 USC § 103***

4. The rejection of Claims 7-11 under 35 U.S.C. 103(a) as being unpatentable over Bolomey et al. (US Patent No. 6,424,597) as applied to claim 1-6 & 12-14 above, and further in view of Bjorner et al. (US Patent No. 5,485,263) is hereby maintained.

### ***Double Patenting***

5. The rejection of Claims 1, 2 & 13 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over patented claim 1 & 3 of U.S. Patent No. 6,424,597 is hereby maintained.

***Response to Arguments***

6. Applicant's arguments filed 12/21/2009 have been fully considered but they are not persuasive. The Examiner acknowledges that the Applicant intends to invoke 35 U.S.C. 112, sixth paragraph as per the Applicant Remarks filed 12/21/2009. However the Examiner contends that 35 U.S.C. sixth paragraph is not being invoked correctly.

According to MPEP 2181, Section I:

A claim limitation will be presumed to invoke 35 USC 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitation must use the phrase "means for" or "step for";
- (B) the "means for" or "step for" must be modified by functional language;
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

7. In reviewing the amended claims, the "means for determining the position of the multiple elements relative to the object" as claimed is modifying the "means for bring the multiple elements into contact". The Claim 1 thus fails the 3-prong test and 35 U.S.C 112, sixth paragraph is not invoked. Further the Examiner notes that while Claim 1 was amended with the intention of properly invoking 35 U.S.C. 112, sixth paragraph, the dependent claims were not properly amended. Applicant removed "means of determining" from the independent claims but the language remains in depending claims such as in Claim 3, Line 6 and thus resulting in lack of antecedent basis issues as well. The Examiner requests that the Applicant properly invoke 35 U.S.C. 112, sixth paragraph as intended throughout all of the claims and not just within the first dependent claim. Where the Applicant intends not to use 35 U.S.C. 112, sixth paragraph, the Examiner suggests avoiding the confusion resulting from "means of" or "means" language by use of terms such as "unit" instead, where appropriate.

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8. The Applicant submitted arguments that Bolomey provided nothing to keep the elements in contact with the object that is being checked during displacements of the transducer during the check and assure coupling with the object. The Examiner respectfully disagrees. *Without properly invoking 35 U.S.C. 112, Sixth Paragraph*, the claim language will be interpreted in light of the Specification but not with details from the Specification read into the claims. The Examiner contends that “means for bring the elements into contact with the surface of the object to be checked” can be broadly interpreted to read on Bolomey as disclosed in Figure 6, Element 56, which performs a similar function. The rejections are deemed proper and are hereby maintained.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELENE BOR whose telephone number is (571)272-2947. The examiner can normally be reached on M-T 8:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on (571)272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. B./  
Examiner, Art Unit 3768

/Eric F Winakur/  
Primary Examiner, Art Unit 3768